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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,994

09/18/2006

Marc Peuker

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10/16/2009

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EXAMINER

PAGAN, JENINE MARIE

ART UNIT

PAPER NUMBER

3728

NOTIFICATION DATE

DELIVERY MODE

10/16/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/598,994	<b>Applicant(s)</b> PEUKER ET AL.	
	<b>Examiner</b> JENINE M. PAGAN	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 55-90 is/are pending in the application.
- 4a) Of the above claim(s) 65-72, 74-83 and 85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55-64, 73, 84, 86, 87, 89 and 90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 65-72, 74-83 and 85 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

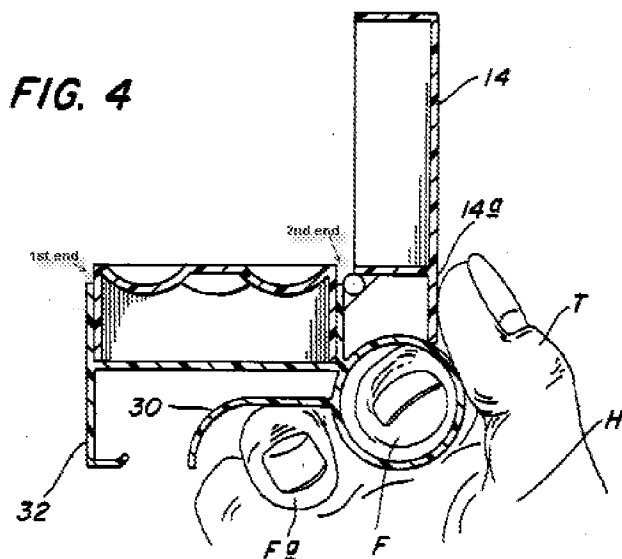
- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

1. This Office Action acknowledges the applicant's amendment filed on 6/15/2009. Claims 55-90 are pending in the application. Claims 65-72, 74-83, 85 and 88 are withdrawn from consideration. Claims 1-54 are canceled.

### ***Claim Rejections - 35 USC § 102***



**2. Claims 55-59, 61, 62, 87, 89 and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by McGarrigle (US 5,249,963).**

**Claim 55:** McGarrigle discloses a package assembly for storing and delivering dental substance:

at least one container 10 comprising a base 12 and a lid 14; and

at least one hinge 16/18 connecting the base 12 and the lid 14;

wherein the base 12 and the lid 14 comprise first 14a and second 26/30 levers, the first 14a and second 26/30 levers are provided at the container 10 essentially on the side of the hinge 16/18 with their free ends extending in essentially the same direction away from the hinge 16/18 when the container is either opened or closed; and wherein the container 10 can be opened or the lid 14 can be removed from the base 12 by moving the free ends of the first 14a and second 26/30 levers towards each other

**Claim 56:** McGarrigle discloses a package assembly for storing and delivering dental substance:

the hinge 16/18 is provided between the first 14a and second 26/30 lever

**Claim 57:** McGarrigle discloses a package assembly for storing and delivering dental substance:

the container 10 comprises a first end next to the base 12 and a second end next to the lid 14, which is adapted for air-tight closing of the container at the second end

(When the lid closes down on the base the container is closed preventing air from entering the container as seen in Figure 3)

**Claim 58:** McGarrigle discloses a package assembly for storing and delivering dental substance:

the end of the second lever 26/30 is bent in a direction away from the first lever 14a (Fig. 3)

**Claim 59:** McGarrigle discloses a package assembly for storing and delivering dental substance:

the container 10 is pre-filled with at least one dental substance

**Claim 61:** McGarrigle discloses a package assembly for storing and delivering dental substance:

the base 12 and/or the lid 14 are manufactured with an opening for filling the container 10 after manufacturing and for sealing with a seal

(When the container is manufactured and filled with substance the lid closes down on the base and the container is sealed together as seen in Figure 3)

**Claim 62:** McGarrigle discloses a package assembly for storing and delivering dental substance (see figure above):

the container 10 is sealed with a seal at the first end

(When the lid closes down on the base the container is sealed together as seen in Figure 3)

**Claim 87:** McGarrigle discloses a method of providing dental substance according to claims 55-59, 61 and 62 (Figure 4):

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opening the initial closed package assembly 10 by pressing the two levers 14a/26/30 together, and taking the substance (Col 2:39-40) out of the container 10

**Claim 89:** McGarrigle discloses a method of providing dental substance according to claim 87, comprising after the second point furthers the step: closing the container 10 by pressing the lid 14 onto the container (Fig. 4)

Regarding to claims 87 and 89, under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). MPEP 2112.02

**Claim 90:** McGarrigle discloses a package assembly for storing and delivering dental substance:

comprising at least one of the materials selected from the group consisting of bonding materials

**3. Claims 60 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarrigle (US 5,249,963) in view of McDevitt et al. (US 5,204,130).**

**Claim 60:** McGarrigle discloses the claimed invention as stated above in claim 55 except:

the base, the lid and the hinge are integrally molded

**However McDevitt discloses:**

the base 20, the lid 24 and the hinge 26 are integrally molded (Col 3:8-9 and 17-19)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the base, lid and hinge integrally molded, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Howard v. Detroit Stove Works, 150 U.S. 164 (1993).

**Claim 87:** McGarrigle discloses the claimed invention as stated above in claim 55 and 60, the method:

opening the initial closed package assembly 10 by pressing the two levers 14a/26/30 together, and taking the substance (Col 2:39-40) out of the container 1

**4. Claims 63-64, 84, 86 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarrigle (US 5,249,963) in view of Keaveney et al. (US 5,938,018).**

**Claim 63:** McGarrigle discloses the claimed invention as stated above in claim 55 and 62 except:

the seal is a foil and/or a plug and/or part of the base

**However Keaveney discloses:**

the seal 24 is part of the base 12

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the seal part of the base as taught by Keaveney,

since Keaveney suggests at column 3 line 52-54 that such a modification would preserve the aroma inside of the container.

**Claim 64:** McGarrigle discloses the claimed invention as stated above in claim 55 and 62 except:

the seal is a foil and/or a plug and/or part of the lid

**However Keaveney discloses:**

the seal 24 is part of the lid 14

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the seal part of the lid as taught by Keaveney, since Keaveney suggests at column 3 line 58-63 that such a modification would preserve the aroma inside of the container.

**Claim 84:** McGarrigle discloses the claimed invention as stated above in claim 55 except:

the package assembly exhibits an orange color to filter blue light while providing a transparent appearance

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the package to exhibit an orange color to filter blue light while providing a transparent appearance since it was known in the pharmaceutical art that is common to provide the color to protect the substance inside of the container while still being able to see what is in the container.

**Claim 86:** McGarrigle discloses the claimed invention as stated above in claim 55 except:



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the lid and/or container comprise a self-cleaning or low energy surface, preferably all surfaces which are supposed to get in contact with the components. It would have been obvious to one having ordinary skill in the art at the time the invention was made to the lid and/or container comprise a self-cleaning or low energy surface, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

**Claim 87:** McGarrigle discloses the claimed invention as stated above in claim 55, 63-64, 84 and 86, the method:

opening the initial closed package assembly 10 by pressing the two levers 14a/26/30 together, and taking the substance (Col 2:39-40) out of the container 1

**5. Claims 73 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarrigle (US 5,249,963) in view of Discko, Jr. (US 5,660,273).**

**Claim 73:** McGarrigle discloses the claimed invention as stated above in claim 55 except McGarrigle does not specifically disclose:

the package comprises a disposable applicator

**However Discko discloses:**

the package 30 comprises a disposable applicator 20

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the package of McGarrigle include a disposable applicator as taught by Discko, since Discko states at column 3 line 50-60 that

such a modification would allow the user to use the material such as bonding agents located inside of the container.

**Claim 87:** McGarrigle discloses the claimed invention as stated above in claim 55 and 73, the method:

opening the initial closed package assembly 10 by pressing the two levers 14a/26/30 together, and taking the substance (Col 2:39-40) out of the container 1

### ***Response to Arguments***

6. Applicant's arguments filed 6/15/2009 have been fully considered but they are not persuasive. The Applicant argues that the reference of McGarrigle does not disclose the first and second levers having free ends extending essentially in the same direction away from the hinge when the container is either open or closed. It is shown in figure 3 of McGarrigle, shows the first lever (14a) having a free end opposite the fixed end that is connected to the container and the second lever (26) having a fixed end connected to the container and the free end on the opposite side not connected to the container.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENINE M. PAGAN whose telephone number is (571)270-3216. The examiner can normally be reached on Monday - Thursday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mickey Yu/  
Supervisory Patent Examiner, Art Unit 3728

/Jenine M Pagan/  
Examiner, Art Unit 3728